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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,524	08/22/2003	Olivier Kern	0515-1066	8120

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EXAMINER

WORRELL JR, LARRY D

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/645,524

Applicant(s)

KERN ET AL.

Examiner

Danny Worrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 8 is/are rejected.
- 7) ☒ Claim(s) 2-7 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/19/03.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by EP patent document 0284797.

EP patent document 0284797 teaches the process as claimed including a support of a shape appropriate to the preform, on which are applied superposed layers of the filaments or sections of filaments crossed in at least two directions, said layers being interconnected by means of filaments or sections of filaments which pass through them, and said filaments or sections being stretched or held on said support by pins, characterized in that it comprises a step of reimplantation of the pins by offsetting them, so as to avoid the concentration of defects inherent in the use of pins.

Claim 8 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP patent document 0284797.

In assessing the subject matter of product-by-process claims, it is necessary to bear in mind certain principles. Foremost among these is the principle that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985); In re Brown, 459 F. 2d 531, 173 USPQ 685 (CCPA 1972); In re Pilkington, 411 F.2d 1345, 162 USPQ 145 (CCPA 1969). Thus, the patentability of a product does not depend on the method of production. Thorpe, supra. If the product in a product-by-process claim is the same as or obvious from a

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product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Thorpe, *supra*; In re Marosi, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983).

The Court of Customs and Patent Appeals discussed these principles as well as the rationale for rejection of such claims over prior art disclosures of products in In re Brown, 459 F.2d 531, 173 USPQ 685 (CCPA 1972) as follows:

In order to be patentable, a product must be novel, useful and unobvious. In our law, this is true whether the product is claimed by describing it, or by listing the process steps used to obtain it. This latter type of claim, usually called a product-by-process claim, does not inherently conflict with the second paragraph of 35 USC 112. [citation omitted] That method of claiming is therefore a perfectly acceptable one so long as the claims particularly point out and distinctly claim the product or genus of products for which protection is sought and satisfy the other requirements of the statute. It must be admitted, however, that the lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith. (emphasis in the original, footnotes omitted).

Thus, although process limitations distinguishing the product over the prior art must be given the same consideration as traditional product characteristics, In re Hallman, 655 F.2d 212, 210 USPQ 609 (CCPA 1981), In re Luck, 476 F.2d 650, 177 USPQ 523 (CCPA 1973), and although product-by-process claims are limited by and defined by the process, determination of patentability remains based upon the product itself, Thorpe, 227 USPQ at 966.

In view of the similarities between the claimed process, i.e. "offsetting pins", and that of the prior art of EP patent cument 0284797, it is reasonable to believe that the product made by the prior art process would be either identical to or

ly slightly different from the claimed product. In such a situation, the burden of proof shifts to applicant to prove that the claimed product is materially different.

Allowable Subject Matter

Claims 2-7 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

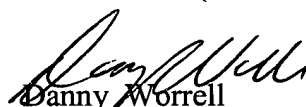
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danny Worrell whose telephone number is 571/272-4997. The examiner can normally be reached on MON, WED-FRI.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on 571/272-4983. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Danny Worrell
Primary Examiner
Art Unit 3765

LDW